

REMARKS

Claims 1, 3-7 and 9-12 are pending in this application. Claims 7 and 9-12 are presently withdrawn by way of a restriction requirement.

By this Amendment, claims 1 and 7 have been amended to incorporate the subject matter of canceled claims 2 and 8, respectively. These amendments clearly distinguish the claimed invention over the teachings of Osawa and Fredrickson discussed below. Claim 3 has been amended to change its dependency from canceled claim 2 to claim 1. The specification has been amended to correct typographical errors.

No new matter is added by this Amendment.

I. Restriction Requirement

The Patent Office alleges that the claims are drawn to two distinct inventions: Group I (claims 1-6) drawn to a method for cutting/shaping a rubber strip into rubber band members and Group II (claims 7-12) drawn to an apparatus for cutting/shaping a rubber strip into rubber band members. This restriction requirement is respectfully traversed.

During a telephone conversation with the Examiner on July 30, 2004, Applicants' representative provisionally elected Group I, claims 1-6, with traverse.

It is respectfully submitted that the subject matter of all claims 1, 3-7 and 9-12 is sufficiently related that a thorough search for the subject matter of any one of Group I would encompass a search for the subject matter of the remaining claims. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden. See MPEP §803 in which it is stated that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in

order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office.

Thus, withdrawal of the Restriction Requirement is respectfully requested

II. Claim Rejections Under 35 U.S.C. §103(a)

Claims 1-4 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,293,795 (hereinafter "Osawa") in view of U.S. Patent No. 4,878,521 (hereinafter "Fredrickson").

Claims 5 and 6 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Osawa in view of Fredrickson and U.S. Patent No. 4,779,658 (hereinafter "Kawabata"). These rejections are respectfully traversed.

First, the Patent Office has shown no motivation as to why one skilled in the art would have combined the references as suggested. Kawabata is directed to pneumatic safety tires, Fredrickson is directed to an apparatus for parting and pasting battery plate grids and Osawa is directed to cutting and shaping belt-like members. Applicants submit that there is no motivation to have combined pneumatic safety tires and an apparatus for parting and pasting battery plate grids with cutting and shaping belt-like members. Further, even if there was somehow motivation to combine the references, the presently claimed invention still would not have been achieved.

The Patent Office acknowledges that Osawa fails to teach or suggest an anvil groove; a press cutter/shaper having a pair of inclined shaping surfaces on front and rear sides; and a cutting blade arranged between the front and rear shaping surfaces of the press cutter/shaper and protruding therefrom toward the anvil groove, wherein the cutting blade is arranged so that at least one of the front surface and rear surface of the cutting blade can be pressed against a corresponding edge of the anvil groove so as to cut the rubber strip at a predetermined cut position, as recited in claims 1 and 7.

More specifically, as recited in claims 1 and 7, and as clearly shown in Fig. 2 of the present invention, Osawa fails to teach or suggest a cutting blade have a front and rear surface that can be pressed against an edge of the anvil groove so as to cut the rubber strip at a predetermined position, i.e., where a surface of the cutting blade is pressed against an edge of the anvil.

Nothing in Fredrickson or Kawabata remedy the aforementioned deficiencies of Osawa. The Patent Office alleges that Fredrickson, at Fig. 3, teaches that two side faces 75 and 77 of the cutting portion 79 contact the upper ends of the groove 91 to cut the grids 31 at two predetermined cut positions. Applicants respectfully disagree.

Fredrickson merely teaches that a cutting edge 81 is substantially prevented from wandering from the cutting plane 83 due to the support afforded to the pointed cutting portion 79 of the cutting disc 65 by the groove 91. See col. 3, lines 60-65 of Fredrickson. There is only one cutting plane taught by Fredrickson. The cutting plane 83 is about centrally located in the groove 91. See col. 3, lines 52-56. Further, the side faces 75 and 77 of the cutting disc 65 engage the side faces 93 and 95 of the groove 91 in the area adjacent the juncture of the groove 91 and the outer surface 92 of the anvil roller 63 to prevent the cutting edge 81 from substantially wandering from the cutting plane 83. See col. 3, lines 56-61 of Fredrickson. Thus, the side faces 75 and 77 taught by Fredrickson merely help to keep the cutting edge 81 from wandering, and do not cut the grids 31 at any position, as alleged by the Patent Office.

For the foregoing reasons, Applicants submit that Osawa, alone or in combination with Fredrickson, fails to teach or suggest a cutting blade have a front and rear surface that can be pressed against an edge of the anvil groove so as to cut the rubber strip at a predetermined position, as recited by claims 1 and 7.

With respect to the rejection of claims 5 and 6, claim 5 depends from claim 1 and claim 6 depends from claim 5. Each of claims 5 and 6 are allowable for the same reasons as claim 1.

The Patent Office alleges that Kawabata teaches a pneumatic safety tire formed from an inner liner N having a protruding rubber member 80 which is supported by a rubber chafer 90 and by a fabric member 91 made of textile cord bonded to the inner liner N. The Patent Office further alleges that it would have been obvious to one of ordinary skill in the art to make the inner liner/chafers assembly used for making a tire in the process of Kawabata to provide quicker tire making by eliminating the step of bonding the chafers to the inner liner during the tire assembly process.

Even if one of ordinary skill in the art would have found Kawabata to teach making the inner liner/chafers assembly used for making a tire, the presently claimed invention still would not have been achieved. Specifically, nowhere does Kawabata teach or disclose a cutting blade to cut a rubber strip at a predetermined cut position, as recited in claims 1 and 7. More specifically nothing in Kawabata remedies the deficiencies of Osawa and Fredrickson noted above with respect to claims 1 and 7.

For the foregoing reasons, Applicants respectfully submit that Osawa, Fredrickson and Kawabata, whether taken alone or in combination, would not have led one of ordinary skill in the art to the invention of independent claims 1 and 7 or dependent claims 3-6 and 9-12. Reconsideration and withdrawal of these rejections are thus respectfully requested.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 3-7 and 9-12 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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